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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): MEDB.P0001

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on 12/15/06

Signature [signature]

Typed or printed name Gregory Suh

Application Number	Filed
09/910,316	07/19/2001

First Named Inventor: Daniel Putterman

Art Unit	Examiner
2623	Salce, Jason

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 48,187

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12/15/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 6 forms are submitted. Form (1 page) + Remarks (5 pages)

Atty File No.: MEDB.P0001

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Gregory Suh

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:
Putterman et al.
Serial No.: 09/910,316
Filing Date: 7/19/2001
For: **HOME MEDIA NETWORK**

Examiner: Salce, Jason
Group Art Unit: 2623

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action mailed on 8/16/2006, Applicants submit the following remarks:

In the Final Office Action dated 8/16/2006: claim 101 was rejected under 35 USC ∫112, first paragraph; claims 85 – 87, 93, 104-106, and 108-110 were rejected under 35 USC 102(b) as being anticipated by USP 5,883,621, to Iwamura (hereinafter Iwamura); claims 101-102 were rejected under 35 USC 103(a) as being unpatentable over Iwamura; claims 88 – 89, 91, and 111 were rejected under 35 USC 103(a) as being unpatentable over Iwamura in view of USP 5,793,366, to Mano et al. (hereinafter Mano); claims 90, 103, and 107 were rejected under 35 USC 103(a) as being unpatentable over Iwamura in view of USP 6,826,512, to Dara-Abrams et al. (hereinafter Dara-Abrams); and claim 92 was rejected under 35 USC 103(a) as being unpatentable over Iwamura in view of USP 6,182,094, to Humpleman et al. (hereinafter Humpleman). Applicants respectfully

traverse the rejections. Claims 85-93 and 101-111 remain pending in this application.

Rejections Under 35 USC ∫112

Claim 101 was rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement and containing subject matter not described in the specification. The Examiner states that claim 101 recites a control and acquisition set-top box that runs, "at least one of a plurality of media applications on a client device...," and notes that paragraphs 0033-0037 and 0040-0041 of the specification teaches that the acquisition set-top box 220 only acquires content objects and does not teach running a media application on one of the attached client devices.

However, paragraph 0038 of the specification states that "...set-top box 230 [control/playback box]... may be incorporated into set-top box 220 [acquisition/storage box]..." Further, paragraph 0052 of the specification states that, "Set-top box 220 [acquisition/storage box] also includes a media playback module 420 and a media control module 450." As such, as described in the specification and as shown in the figures (see Figures 2 and 7), the acquisition box may, in some embodiments, run "at least one of a plurality of media applications on a client device," as recited in claim 101. Therefore, claim 101 was improperly rejected under 35 USC ∫112, first paragraph.

Rejections under 35 USC ∫102(b)

Claims 85 – 87, 93, 104-106, and 108-110 were rejected under 35 USC ∫102(b) as being anticipated by Iwamura. Applicants respectfully traverse these rejections. Claim 85 recites a home media system comprising:

> network;
> acquisition storage set-top box, coupled to said network, for storing at least one digital data content object;
> control/playback set-top box, coupled to said network,

comprising a media playback module and a media control module, said media control module comprising an applications module for **accessing, across said network, at least one digital data content object from said acquisition storage set-top box**, and for running at least one media application that provides functionality, through a user interface, to play media, said media playback module comprising a **decoder for decoding media comprised in said digital data content object**; and

client device, coupled to said control/playback set-top box, for displaying said user interface for said media application and for playing media comprised in said digital data content object.

[Emphasis added.]

The Examiner stated, in part, that Iwamura discloses a home media system having a network 10, an acquisition storage set-top box (DVCR1 108 in Figure 1), coupled to network, for storing a digital data content object (recording digital content from a DVD or digital broadcasts to DVCR1), control/playback set-top box (IRD 100), coupled to network, comprising an applications module for accessing, across said network, at least one digital data content object from said acquisition storage set-top box (transferring digital data content object from DVCR1 to the IRD 100 through network 10) and a decoder for decoding media comprised in said digital data content object (MPEG decoder in FIG. 2b).

However, as disclosed in Iwamura, the MPEG decoders 326 and 328 of the IRD 100 are used only in the tuner function of the IRD 100 to decode signals received from a satellite 201. As stated in column 3, line 66 to column 4, line 19 of Iwamura:

> Antenna 202 receives a signal 200 from a satellite 201... the desired channel from signal 200 is selected for processing and passed to demodulator 206... The decoded signal 205 is then passed to main block 208 for further processing... decoded signal 205 is first parsed in Transport Packet Parser (TPP) 300 and then decrypted in DES engine 302. The resulting signal is then stored in an external RAM 304... the stored signal is retrieved from external RAM 304 and transmitted via traffic controller 306 to either MPEG video decoder 326 or MPEG audio decoder 328, as appropriate.

As such, in Iwamura, the decoders 326 and 328 are used to decode signals received from a satellite 201. However, such signals are not accessed by the IRD across a network, but are received and processed by the IRD via an antenna 202 and tuner 204. As shown in Figures 2a and 2b of Iwamura, the received satellite signal path goes through the IRD 100 (e.g., through tuner 204, main block 208, etc.) and does not pass through the network (see bottom of Figure 2b "1394 network to other devices").

Also, no where in Iwamura is it taught or suggested that the decoders 326 or 328 are used to decode digital objects from devices on the network (such as DVCR1, DVD, etc.), as suggested by the Examiner. Further, as known in the art, the various network devices of Iwamura (e.g., DVD 106, DVCR1 108, etc.) do not require a separate external decoder for playback operation. For example, as known in the art, a DVD provides a video output that can be displayed on a display without further processing (decoding) prior to display. In other words, additional decoding by MPEG decoders 326 and 328 of digital content on the various network devices is simply not needed and would be inconsistent with common knowledge in the art as well as the disclosure of Iwamura. In contrast, as recited in claim 85, a digital data content object is accessed across a network and decoded by a decoder.

As such, Iwamura does not teach or suggest a control/playback box comprising an applications module for **accessing, across a network**, a **digital data content object** from a acquisition storage box, and a **decoder for decoding** media comprised in said digital data content object, as required in claim 85. As such, Applicants submit that claims 85 – 87, 93, 104-105 are in allowable form. Independent claim 106 contains the "digital data

content object across a network" and "decoder for decoding media" limitations of claim 85. As such, claims 106 and 108-110 are also in allowable form.

Rejections under 35 USC §103(a)

Claims 101-102 were rejected as being unpatentable over Iwamura. Independent claim 101 contains the "digital data content object across a network" and "decoder for decoding media" limitations of claim 85. As such, claims 101-102 are in allowable form. Claims 88 – 89, 91, and 111 were rejected as being unpatentable over Iwamura in view of Mano but are dependent on claim 85 and in allowable form. Claim 111 is dependent on claim 106 and in allowable form. Claims 90, 103, and 107 were rejected as being unpatentable over Iwamura in view of Dara-Abrams. Claims 90 and 103 are dependent on claim 85 and claim 107 is dependent on claim 106 and are in allowable form. Claim 92 was rejected as being unpatentable over Iwamura in view of Humpleman but is dependent on claim 85 and in allowable form.

In view of the foregoing, it is submitted that the claims are in condition for allowance. Withdrawal of the final rejections is requested.

Respectfully submitted,

STATTLER/JOHANSEN & ADELI LLP

Dated: December 15, 2006

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